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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,317	02/08/2001	Tsuguhide Sakata	1232-4681	4553
27123	7590	06/08/2005	EXAMINER	
MORGAN & FINNEGANT, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			ENG, GEORGE	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/779,317	SAKATA, TSUGUHIDE	
	<b>Examiner</b>	<b>Art Unit</b>	
	George Eng	2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 February 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Amendment***

1. This Office action is in response to the amendment filed 2/2/2005. Accordingly, claims 1-19 are pending for examination.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly amended claims 1, 7 and 13-19 contain inhibition means, which was not adequately written in the specification. Although the specification mentions that it is impossible to change to STB mode when the terminal body is in starting to receive a video telephone call from the opposite party in DVC mode, the specification fails to explicitly define to use inhibition means or include inhibition step to make the process. Note the specification fails to contain the written description of the invention, and of the manner and process using it. Thus, claims 1, 7

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and 13-19 fail to comply with the written description requirement, and to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 2-6 and 8-12 are also rejected because of depending on claims 1 and 7, respectively, containing the same deficiency.

### *Drawings*

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the inhibition means must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 7-10 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapp et al. (US PAT. 6,073,192 hereinafter Clapp) in view of Rodriguez et al. (US PAT. 5,999,207 hereinafter Rodriguez), Chivers (US PAT. 4,376,973) and Catanzaro et al. (US PAT. 5,502,727 hereinafter Catanzaro).

Regarding claim 1, Clapp discloses a communication device (242, figure 7) for communicating in video and audio with another terminal device (262, figure 7) comprising an external connection interface (142, figure 5) for connecting with an external data processor (72, figure 5), communication means (170, figure 5) for exchanging information with the other terminal device, video input means (78, figure 5), video output means (76, figure 5), audio input means (80, figure 5), audio output means (220, figure 5), and control means (200, figure 5) for controlling an operation (col. 8 line 17 through col. 19 line 34). Note while Clapp teaches the communication device capable of providing stand-alone video conferencing capability to output video data to be displayed to the video output means in accordance with an operation, i.e., a first

operation mode (col. 7 lines 17-29), and to transfer video data to be display to the external processor (72) in accordance with control commands received from the external data processor through the external connection interface, i.e., a second operation mode, when the communication device is coupled to the external processor (col. 7 lines 30-49) so that Clapp obviously includes mode-setting means for setting the first operation mode for unassisted operation or the second operation mode for operation under the control of the external processor and mode selecting means for automatically selecting between the first operation mode when the communication device is not connected with the external processor and the second operation mode when the communication device is connected with the external processor. Thus, the communication device is capable of automatically selecting either in the first operation mode for unassisted operation or in the second operation mode for operation under the control of an external data processor depending upon the communication device being connected with the external data processor or not. Clapp differs from the claimed invention in not specifically teaching the communication comprising operation means. However, it is notoriously well known in the art of a stand-alone video communication device comprising operation means in order to allow a user to access video communication functionalities with an input control device, for example see Rodriguez (abstract and col. 1 line 66 through col. 2 line 67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Clapp in having the operation means in the stand-alone communication device, as per teaching of Rodriguez, because it makes user friendly so that it allows the user to access video communication functionalities with the input control device. Note Clapp further teaches control commands, i.e., instructions, being generated by application software running in the external data

processor (72, figure 5) during the second operation mode (col. 7 lines 30-65), and the communication device providing stand-alone video capability when it is not connected to the external data processor, (col. 7 lines 17-29) so that one skill in the art would recognize the communication device of Clapp transitioning to the stand-alone video capability, i.e., first operation mode, when the external data processor is disconnected or the application running in the external data processor is terminated. In addition, neither Clapp nor Rodriguez specifically teaches transition of the second operation mode to the first operation mode is made automatically when the application program is terminated during the operation of the external data processor in the second operation mode. However, it is old and notoriously well known in the art of a processor capable of switching from a first operation mode to a second operation mode when execution of a program is completed in order to improve an operability of the processor by automatically switching from one operation mode to another operation mode when the program is completed, for example see Chivers (col. 1 lines 50-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Clapp and Rodriguez in having the transition of the second operation mode to the first operation mode is made automatically when the application program is terminated during the operation of the external data processor in the second operation mode, as per teaching of Chivers, in order to improve an operability of the processor by automatically switching between different operation modes when the program is completed. Furthermore, the combination of Clapp, Rodriguez and Chivers differs from the claimed invention in not specifically teaching the communication device having inhibition means for inhibiting change from the first operation mode to the second operation mode or change from the second operation mode to the first

operation mode, while communication with the other terminal device. However, Catanzaro teaches an image and audio communication system comprising a power switch (255, figure 2), read as inhibition means, for preventing change from video digital connection mode, i.e., a first operation mode, to voice mode, i.e., a second operation mode, while communicating with other terminal in order to improve operability (col. 5 lines 43-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Clapp, Rodriguez and Chivers, in having inhibition means for inhibiting change from the first operation mode to the second operation mode or change from the second operation mode to the first operation mode, while communication with the other terminal device, as per teaching of Catanzaro, in order to improve operability.

Regarding claims 2-3, Clapp teaches the communication device provides stand-alone video conferencing capability such that the communication device is automatically operating in the first operation mode after power is supplied (col. 7 lines 17-29 and col. 16 lines 19-50), and the communication device is operating in the second operation mode in accordance with a control instruction with the external processor when the communication device is coupled with the external processor (col. 7 lines 30-49 and col. 16 lines 51-66). Thus, it recognizes the mode setting means set the first operation mode in response to the connection state with the external processor changing to a substantially disconnected state.

Regarding claim 4, Clapp teaches the communication device capable of operating in accordance with a control signal control from the external processor (col. 7 lines 30-35).

Regarding claim 7, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claims 8-9, the limitations of the claims are rejected as the same reasons set forth in claims 2-3.

Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 4.

Regarding claims 13-19, the limitations of the claims are rejected as the same reasons set forth in claim 1.

7. Claims 5-6 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapp et al. (US PAT. 6,073,192 hereinafter Clapp) in view of Rodriguez et al. (US PAT. 5,999,207 hereinafter Rodriguez), Chivers (US PAT. 4,376,973) and Catanzaro et al. (US PAT. 5,502,727 hereinafter Catanzaro) as applied in claims above, and further in view of Kato et al. (US PAT. 5,898,824 hereinafter Kato).

Regarding claims 5-6, Clapp teaches the communication device comprising a recording medium (col. 8 line 25). The combination of Clapp, Rodriguez, Chivers and Catanzaro differs from the claimed invention in not specifically teaching recording management means for recording data to be recorded in the external data processor when the recording medium has its space area less than a predetermined amount, and recording management information indicating that the data is recorded in the external processor on the recording medium, wherein the management means checks on the basis of the management information as to whether or not data to be reproduced exists in the recording medium and reproduces the data when it exists in the recording medium and request the external data processor to transfer the data when it exists in the external data processor. However, Kato teaches a method for improve a storage capacity of a

communication device, i.e., a facsimile device, connected with a computer comprising detecting means, i.e., management means, for checking a residual amount of storage capacity of a first storage in the communication device, selecting a second storage in the computer for storing data when detecting means detecting that the first storage has its space area less than a predetermined amount, and means for determining whether the data is stored in the first storage or the second storage in order to reproduce the data being stored in the second storage when it exists in the computer (col. 10 line 50 through col. 14 line 67) so that it recognizes the detecting means recording management information indicating that the data is recorded in either the communication device or the computer. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Clapp, Rodriguez, Chivers and Catanzaro in having the management means, as per teaching of Kato, because it improves the storage capacity of the communication device.

Regarding claims 11-12, the limitations of the claims are rejected as the same reasons set forth in claims 5-6.

*Response to Arguments*

8. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

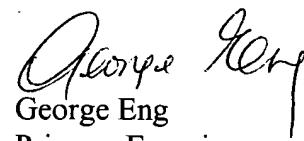
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (571) 272-7495. The examiner can normally be reached on Tue-Fri 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



George Eng  
Primary Examiner  
Art Unit 2643

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